

PATENT

Atty Docket No.: 200403364-1
App. Ser. No.: 10/830,218

REMARKS

Favorable reconsideration of this application is respectfully requested in view of amendments above and the following remarks. Claims 1-27 are pending in the present application of which claims 1, 15, 20, 24 and 27 are independent.

Claims 15, 17, and 20 were objected to because of informalities.

Claims 3-8 and 26 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7, 9-10, 13-17, and 19-27 were rejected under 35 U.S.C. §102(e) as being anticipated by Ranganathan et al. (2003/0156074).

Claims 8 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ranganathan et al. (2003/0156074).

Claims 11-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ranganathan et al. (2003/0156074) in view of Schleicher et al. (2002/0138744).

These rejections are traversed for the reasons stated above.

Drawings

The Office Action Summary did not indicate whether the formal drawings filed with the application are accepted. The Examiner is requested to provide this indication in the next communication.

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Claim Objections

Claims 15, 17 and 20 were objected to for minor informalities. These claims have been amended to overcome the objections.

Claim Rejection Under 35 U.S.C. §112

Claims 3-8 and 26 were rejected under 35 USC §112 second paragraph as being indefinite. In particular claims 3 and 26 were cited as being indefinite because it is allegedly unclear which claimed metrics the term "some" is referring to in line 4 of each of the claims.

Claim 3 recites, "the plurality of metrics including at least some of a usage metric, a power consumption metric, a lifetime metric, and the cost metric." Claim 26 has a similar recitation. The Applicant believes it is clear that "some" refers to all the metrics that directly follow, namely, a usage metric, a power consumption metric, a lifetime metric, and the cost metric. Thus, claims 3-8 and 26 are believed to be definite, and the rejection under 35 USC §112 second paragraph should be withdrawn.

Claim Rejection Under 35 U.S.C. §102(c)

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

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Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-7, 9-10, 13-17, and 19-27 were rejected under 35 U.S.C. §102(c) as being anticipated by Ranganathan et al. (2003/0156074 which is U.S. Patent Application Serial Number 10/081,720, referred to as the '720).

Parthasarathy Ranganathan is a co-inventor on the '720 and is the sole inventor on the present application.

The rejection states that this rejection under 35 U.S.C. §102(e) may be overcome by submitting a declaration under 37 CFR 1.132 that any invention disclosed in the '720 was derived from the inventor, i.e., Parthasarathy Ranganathan, and is thus not the invention by another.

Accordingly, attached is a declaration from Parthasarathy Ranganathan indicating that the cost metric disclosed in the '720 and relied upon by the Examiner to reject independent claims 1, 15, 20, 24 and 27 was invented only by Parthasarathy Ranganathan. Accordingly, relevant portions of the '720 used to reject independent claims 1, 15, 20, 24 and 27 were not invented by another, and the '720 cannot be used to reject the claims of the present application.

Accordingly, claims 1-27 are believed to be allowable.

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Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S., 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S., 82 USPQ2d 1385 (2007).

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Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness."

Furthermore, as set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385.

If the above-identified criteria and rationales are not met, then the cited references fail to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited references.

Claims 8 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ranganathan et al. (2003/0156074).

Claims 11-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ranganathan et al. (2003/0156074) in view of Schleicher et al. (2002/0138744).

Claims 8, 11-12 and 18 are believed to be allowable for at least the foregoing reasons.

Furthermore, the Official Notice taken with respect to the rejection of claims 8 and 18 is traversed because ranking different options based on a weighting algorithm giving weights to metrics for controlling a display is not believed to be well known at the time of the invention. If the rejection is maintained, the Examiner must provide a reference teaching the claimed features.

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Conclusion

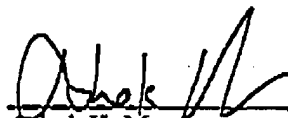
In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: February 26, 2008

By


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